

REMARKS

I. Introduction

Claim 20 is canceled without prejudice, and therefore claims 18, 19 and 21 to 40 are now pending in the present application. Claims 31 to 40 have been withdrawn from further consideration, so claims 18, 19 and 21-30 are under consideration. Claim 18 has been amended. Applicants hereby respectfully request further examination and reconsideration of the application.

II. Rejection of Claims 18 to 30 under 35 U.S.C. §103(a)

Claims 18 to 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,661,303 (“Teder”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended independent claim 18 recites, in relevant parts, “reworking the sensor seating surface . . . to align the sensor axis of an installed sensor in the nominal direction . . . and connecting the sensor to the holding element at the reworked sensor seating surface.” The Examiner admits that Teder does not disclose these claim features, but contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such a reworking step in order to ensure that the device is functional. First, since this contention is solely based on the Examiner’s knowledge and opinion, the Examiner is respectfully requested to provide published information and/or affidavits, pursuant to 37 C.F.R. § 1.104(d)(2). Second, it is well-established that, in order to support an obviousness conclusion, the asserted modification cannot change the principle of operation of the prior art invention being modified. MPEP 2143.01 VI (citing *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959)). As explained in detail below, the modification asserted by the Examiner is not only contradicted by the teachings of Teder, but also directly changes the core principle of operation of Teder.

In contrast to the features of claim 18, Teder teaches a sensor with a printed circuit board that is parallel to the inner surface of the windshield. (Teder, col. 4, ll. 21-23). “Surface mounted emitters and detectors, which are very cost and space efficient, are mounted on the circuit board with an initial optical axis perpendicular to the circuit board.” (Teder, col. 4, ll. 23-26). Accordingly, the proper angles of the emitters and detectors are determined and set during fabrication of the circuit board, i.e., the circuit board is designed so that that the proper angles result when the circuit board is installed parallel to the inner surface of the windshield, and therefore no reworking step is even contemplated in installing the circuit board parallel to the inner surface of the windshield. Therefore, the modification asserted by the Examiner would clearly change the principle of operation of the Teder reference, thereby directly negating the obviousness conclusion as a matter of law. Accordingly, independent claim 18 is allowable.

Independent of the above, claim 18 has been amended to include the features of claim 20, i.e., amended claim 18 recites, in relevant part, “**ascertaining a deviation, present without reworking, of the sensor axis from a nominal direction; reworking the sensor seating surface, based on the ascertained deviation, to align the sensor axis of an installed**

sensor in the nominal direction; and connecting the sensor to the holding element at the reworked sensor seating surface.” In this regard, to the extent the Examiner takes official notice with respect to the features previously recited in claim 20, Applicants respectfully traverse this statement of official notice and respectfully request that the Examiner provide the Applicants with published information and/or affidavits in support of the official notice, pursuant to 37 C.F.R. § 1.104(d)(2). Independent of the above, the combination of Teder with the knowledge of one of ordinary skill in the art cannot render obvious the features of amended claim 18. Considering the moisture sensor disclosed in Teder, there would be no reason to **ascertain a deviation, present without reworking, of the sensor axis from the nominal direction**, since the circuit board is designed so that that the **proper angles result when the circuit board is installed** parallel to the inner surface of the windshield, and therefore no reworking step is even contemplated in installing the circuit board. Accordingly, with regards to the Teder moisture sensor, there is neither a reason nor an opportunity to **ascertain a deviation of any sensor axis from a nominal direction**. Therefore, independent claim 18 is allowable.

Applicants note that claims 19 and 21 to 30 ultimately depend from claim 18, which has been explained above as being allowable over Teder. Accordingly, without passing judgment on the merits of the Examiner’s official notice regarding the limitations of claims 21 and 24 to 28, Applicants note that claims 21 and 24 to 28 are allowable over Teder by virtue of ultimate dependence of claims 21 and 24 to 28 on allowable claim 18. In addition, without passing judgment on the merits of the Examiner’s assertion regarding the teachings of Teder as applied against claims 19, 22, 23, 29, and 30, Applicants note that claims 19, 22, 23, 29, and 30 are allowable over Teder by virtue of ultimate dependence of claims 19, 22, 23, 29, and 30 on allowable claim 18. In summary, claim 18 and its dependent claims 19 and 21 to 30 are allowable.

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Conclusion

In view of the foregoing, it is respectfully submitted that pending claims 18, 19, and 21 to 30 are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
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